

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed July 29, 2004. Claims 15, 20 and 23 are amended herein, and claims 1-29 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Final Rejection

In the summary page of the Office Action, the Examiner indicated that the Office Action was non-final, but in the text of the detailed action the Examiner indicated that the action was final. Applicants were left not knowing whether the Office Action really is final. This amendment is entitled “Amendment After Final Rejection” and is filed using the after-final expedited procedure. Nonetheless, in view of the ambiguity in the Office Action, Applicants respectfully request that the Examiner treat the Office Action as non-final, and this amendment as a non-final amendment.

Claim Objections

The Examiner objected to claims 2 and 15 because of some informalities. In claim 2, at line 1, the Examiner objected to a punctuation error and required that “ are bars,-.” be replaced with --are bars--. Applicants have reviewed the previous amendment made to this claim and determined that the previous amendment results in the punctuation required by the Examiner. In the previous amendment, a bar appears directly above the comma, not beside the comma as shown by the Examiner. In the strikethrough notation now required for amendments, the bar directly above the comma indicates that the comma is deleted; with the comma deleted, the claim has the proper punctuation. Applicants respectfully submit that the Examiner’s objection is therefore moot.

In claim 15, at line 7, the Examiner required that “it” be replaced with --the confirmation projector--. Applicants have amended claim 15, line 7, to replace “it” with --the image processor--, instead of --the confirmation projector-- as requested by the Examiner. This amendment more accurately captures the function of the apparatus, since it is the image processor that signals to the confirmation projector that the image has been processed. Applicants respectfully submit that this amendment to claim 15 overcomes the Examiner’s objection. Although not required by the Examiner, Applicants have similarly amended claim 23

to replace “it” with --the image processor--so that claim 23 will be consistent with the other claims.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 15 and 20 under 35 U.S.C. § 112, second paragraph, for failing to set forth the subject matter that Applicants regard as their invention. Specifically, the Examiner alleges that “projecting a non-targeted confirmation beam onto the plane . . .” is indefinite because it is unclear how the beam can be projected onto the plane of the target without being targeted.

Applicants have amended claims 15 and 20 to remove the language cited by the Examiner. Applicants submit that this overcomes the Examiner’s rejections, and respectfully request withdrawal of the rejections and allowance of the claims.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 6, 7, 10 and 13 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,736,321 to Tsikos *et al.* (“Tsikos”). Applicants respectfully traverse the Examiner’s rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Tsikos cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1 recites an apparatus combination including a base capable of receiving a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the base, wherein the projections of the beams of light on the plane are geometric shapes, and “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of the distance between the lens and the plane” when the lens is installed on the base. Tsikos does not disclose a combination including the recited limitations. As shown in Figures 1A, 4A, 5A and 6A, the Tsikos apparatus includes two co-linear light sources that project two planar beams of light (7A and 7B) onto a plane. With this arrangement, the projections on the plane of the beams 7A and 7B do not *intersect*, but instead *overlap* to form a single line 12. Moreover, because the beam projections overlap but do not intersect, the single line 12 cannot indicate where the center of the field of view is. Tsikos therefore cannot disclose, teach or suggest a combination “wherein an

intersection of the geometric shapes is at the center of the field of view of the lens independent of the distance between the lens and the plane.” Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claims 6 and 7, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See, e.g.*, MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicants submit that claims 6 and 7 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited in the claims. Applicants respectfully request withdrawal of the rejections and allowance of these claims.

Claim 10 recites a method combination including projecting a first light beam onto a plane, wherein the projection of the first light beam on the plane is a first geometric shape; projecting a second light beam onto the plane, wherein the projection of the second light beam on the plane is a second geometric shape; and aligning the first and second beams “such that an intersection of the first and second geometric shapes is at the center of the field of view of a lens of a camera, independently of the distance between the lens and the plane.” By analogy to the discussion above in connection with claim 1, Tsikos does not disclose, teach or suggest a combination including these limitations. Applicants submit that the claim is therefore allowable, and respectfully request withdrawal of the rejection.

As to claim 13, if an independent claim is allowable then any claim depending therefrom is also allowable. *See, e.g.*, MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 10 is in condition for allowance. Applicants submit that claim 13 is therefore allowable by virtue of its dependence on an allowable independent claim, as well as by virtue of the features recited in the claim. Applicants respectfully request withdrawal of the rejection and allowance of this claim.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2-5, 8-9, 11-12 and 14-29 under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over, various combinations of the following references: Tsikos, U.S. Patent No. 5,598,007 to Bunce *et al.* (“Bunce”) and European Patent No. EP1128315 to Rigoni *et al.* (“Rigoni”).

As to claims 2-5, 8-9 and 11-12 and 14, Applicants respectfully traverse the Examiner's rejections. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 1 and 10 are neither anticipated nor obvious, and are therefore in condition for allowance. Applicant respectfully submits that claims 2-5 and 8-9 are therefore allowable by virtue of their dependence on allowable claim 1, as well as by virtue of the features recited therein. Similarly, claims 11-12 and 14 are allowable by virtue of their dependence on allowable claim 10, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

As to claims 15, 20 and 23, Applicants respectfully traverse the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. Applicants respectfully submit that, as explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 15 was rejected by the Examiner as obvious over Tsikos in view of Rigoni. Claim 15, as amended, recites an apparatus combination including a base capable of receiving a camera including a lens, an image processor capable of being coupled to the camera for processing an image of a target captured by the camera, and a confirmation projector coupled to the image processor, wherein "the projector emits an unfocused confirmation beam onto the plane of the target when the image processor signals the confirmation projector that the image processor has processed the image." The Examiner concedes that Tsikos does not disclose a confirmation beam for confirming the processing of the image, but alleges that Rigoni discloses this feature. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tsikos with Rigoni to arrive at the claimed invention.

Applicants respectfully disagree. Rigoni discloses that a confirmation beam should be tightly focused directly on and very closely around the symbol being read, where it is likely to capture the attention of the user. Rigoni therefore cannot disclose, teach or suggest a combination including a confirmation projector wherein "the projector emits an unfocused confirmation beam onto the plane of the target when the image processor signals the

confirmation projector that the image processor has processed the image.” Since the Examiner concedes that Tsikos also does not disclose this element, the combination of Tsikos and Rigoni cannot disclose every element and limitation of the claim and therefore cannot render the claim obvious. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 20 was rejected by the Examiner as obvious over Tsikos in view of Rigoni. Claim 20, as amended, recites a process combination including capturing an image of a target on a plane using a camera, processing the image captured by the camera using an image processor, and “projecting an unfocused confirmation beam onto the plane when the image processor signals to the confirmation projector that the image processor has processed the image.” By analogy to the discussion above in connection with claim 15, Applicants submit that Tsikos and Rigoni cannot render the claim obvious because, even when combined, they do not disclose every element and limitation of the claim. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Claim 23 was rejected by the Examiner as obvious over Tsikos in view of Rigoni. Claim 23 recites an apparatus combination including a base capable of receiving an image processor and a camera including a lens and a projector coupled to the base and adapted to project a plurality of beams of light onto a plane positioned at a focus distance from the lens, wherein the projections of the beams of light on the plane are geometric shapes, and “wherein an intersection of the geometric shapes is at the center of the field of view of the lens independent of distance between the lens and the plane” when the lens is installed on the base. By analogy to the discussion above for claim 1, Tsikos does not disclose, teach or suggest a combination including these elements and limitations. Rigoni also does not disclose, nor has the Examiner alleged that it discloses, these limitations. The combination of Tsikos and Rigoni therefore cannot disclose every element and limitation in the claim. Applicants submit that Tsikos and Rigoni therefore cannot render this claim obvious and respectfully request withdrawal of the rejection.

Regarding claims 16-19, 21-22 and 24-29, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 15, 20 and 23, as amended, are in condition for allowance. Applicants submit that claims 16-19 are therefore allowable by virtue of their dependence on allowable claim 15, as well as by virtue of the features recited

therein. Similarly, claims 21-22 are allowable by virtue of their dependence on allowable claim 20, as well as by virtue of the features recited therein, and claims 24-29 are allowable by virtue of their dependence on allowable claim 23, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 10-29-04

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